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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,711	07/25/2001	Takashi Shigetomi	8694.49USC1	8038

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EXAMINER
PEYTON, TAMMARA R

ART UNIT	PAPER NUMBER
2182	

DATE MAILED: 07/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/912,711	SHIGETOMI ET AL.	
	Examiner	Art Unit	
	Tammara R Peyton	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 July 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. *09/052,408* .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 1-12, 17-21, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asakura, patent no. 5,119,353 and Chan et al., (hereafter Chan), patent number 5,951,687.

2. As per claim 1-12, 24, and 25, Asakura teaches of a storage medium (optical disk 1, Fig.1) having an information storage portion (storage area, 1', Fig. 1) and an electronic circuit portion (IC chip, 2, Fig. 1) for processing the information, said information storage portion storing information to be used in an external system (computer, 10, Fig. 2). Asakura teaches that said electronic circuit portion include response means that interacts with the computer wherein the electronic circuit portion is programmed to upload previously stored information in response to a request from the computer, i.e. dictionary words or audio/video

game information. However, Asakura does not clearly teach of incorporating discrimination/selecting means for discriminating whether or not the external system is matched with the information stored in the information storage portion. [Asakura, Note Abstract, col. 1, lines 59--col. 2, lines 1-65]

3. Chan teaches of a discriminating/selecting means (via disk controller, 14, Fig. 1) incorporated in an internal storage medium (storage device, 10, Fig. 1) having an information storage portion (on storage disk, 14, Fig. 1) which stores a plurality of information to be used in an internal system and an electronic circuit portion (disk controller, 14, Fig. 1) for processing the information, said information storage portion storing information to be used in an internal system (computer, 12, Fig. 1). Chan teaches that said electronic circuit portion (disk controller, 14, Fig. 1) is previously loaded with a plurality of operating drivers that allows the storage medium to emulate in multiple types of computers. Depending on the particular operating driver chosen from an user interface, the disk controller determines if the user's request can be matched with the information stored in the information storage portion (on storage disk, 14, Fig. 1), if so, the data is uploaded from the storage medium to the computer,

12, Fig. 1. [Chan, Note Abstract, col. 3, lines 14-17, 25--67 and col. 6, lines 61-col. 7, lines 1-9]

4. Asakura teaches wherein data maybe written into and read out of the EEPROM chip; and, it would have been obvious to one of ordinary skill that Asakura's inherently incorporates response means for the EEPROM integrated chip to react to a request from the system to read information incorporated on the optical disk portion. One of ordinary skill would readily realize that with little programming effort, Asakura 's EEPROM chip could be reprogrammed with the same functions that of Chan's disk controller and the Asakura's information storage portion could hold the plurality of operation drivers of Chan's storage disk, 14. Chan's disk controller prompts the user to choose from a plurality of emulated operating drivers and uploads from the storage disk the corresponding program once the choice is made.

5. Therefore, it would have been obvious to one of ordinary skill at the time the invention to reprogram the limitations of Chan into the EEPROM integrated chip and storage portion of Asakura's optical disk in order to simplify the interaction between hardware models and system processes; consequently, eliminating the need for extra diskettes which would achieves

similar functions because the multiple types of operating drivers are stored on a single optical disk thereby decreasing the restriction between hardware and software model [Specification, page 2,lines 13-16].

6. As per claims 17 and 19, Specification states that the "notifying means for notifying an identifier" is an ID that separates the different emulation forms for particular operation systems (Specification, pg. 12, Fig.3). Asakura-Chan teaches a storage disk being previously supplied with a plurality of operating drivers that will correspond with a particular user choice. Depending on the particular operating driver chosen, the EEPROM (disk controller) is "notified" to perform the necessary uploading sequence operation corresponding to the selected operating driver.

7. Therefore, it would have been obvious to one of ordinary skill to include a notifying means that notifies an identifier to one of the plurality of operating drivers located in the electronic circuit portion because it would ensure that the appropriate operating drivers is chosen based on the particular system chosen. [See paragraph 2-5]

8. As per claim 18, official notice it taken that the external system is a computer system that processes a digital image data, and that the information stored in the information storage portion is a digital image data taken by a digital camera, because the external system could be a host of computer systems that processes a variety of data and not just digital image data.

9. As per claim 20, it would have been obvious to one of ordinary skill that Asakura-Chan would also have a software interpreter that will execute the driver code for a different computer system. [See paragraph 2-5]

10. Claims 13-16, 22, and 26, are rejected under 35 U.S.C. 103(a) as being unpatentable over Asakura, patent no. 5,119,353 and Chan et al., (hereafter Chan), patent number 5,951,687 and in further view of Momose, Japanese Patent No., JP408123635.

11. As per claim 13-16, 22, and 26, Asakura nor Chan disclose that the external system is not a computer system having a printer, nor that the information stored in the information storage portion is a parameter for adjusting a print condition. However, Momose does disclose that the external system is a computer system (CPU, 19) wherein the computer system is

incorporated in a printer, wherein a suitable driver is downloaded to the printer, 3 in order for the computer system, 1 to utilize it. Further, the Specification defines a "print condition" as a size and a tone, a printer content, etc. (Specification, pages 16-17) and a "print environment" as a temperature or a humidity (Specification, page 17), therefore, it would have been obvious to one of ordinary skill that the particular driver chosen would incorporate instructions that would determine the output quality, i.e. size or tone, and include maintenance instructions on what environment the printer, 3 should operate in wherein the particular drive chosen would conforms to these characteristics.

12. It would have been obvious for one of ordinary skill to include the limitation of Momose with the Asakura-Chan to include the external computer uploading a suitable operating driver for a peripheral device connect to the external system because it would expand and add flexibility of the Asakura-Chan system by eliminating the need for an extra diskette contenting the peripheral's particular driver.

13. Claims 23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asakura, patent no. 5,119,353 and Chan

et al., (hereafter Chan), patent number 5,951,687 and in further view of Schmidt et al., (hereafter Schmidt), patent no. 5,423,054.

14. As per claim 23 and 27, Asakura-Chan teaches a method of the claimed invention, therefore it would have be obvious to one of ordinary skill that the Asakura-Chan system would also teach the code for reading a specific operating driver ID corresponding to the chosen operating driver from the optical disk to the computer. Asakura-Chan is silent to the computer system further including a printer.

15. However, Schmidt discloses a computer system that incorporates a printer, 66, Fig. 12, and more importantly teaches of a storage media (disk, 10, Fig. 1) interfaced with a computer (PC, 62, Fig.12), wherein the computer reads an identifier or key from a electronic circuit (integral data processing system, 22, Figs. 2a-2c located within the storage media disk, 10, Fig.1) and the computer controls the writing of the information stored in the information storage portion (NVROM, 38, Fig. 2a located within the storage media disk, 10, Fig.1) to the computer. [Schmidt, PC, 62, Fig. 12, col. 12, lines 49-68, col. 13, lines 7-10]

16. It would have been obvious to one of ordinary skill at the time the invention was made to combine the limitations of Schmidt with Asakura-Chan because it would add more flexibility to the system.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tammara Peyton whose telephone number is (703) 306-5508. The examiner can normally be reached between 6:30 - 4:00 from Monday to Thursday, (I am off every first Friday), and 6:30-3:00 every second Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin, can be reached on (703) 308-3301. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Mailed responses to this action should be sent to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231.

Faxes for Official/formal communications intended for entry should be sent to:

(703) 746-7238, After Final (703) 746-7239

or, for informal or draft communications, to:

(703) 746-7240 (please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to:

Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (Receptionist).

Tammara Peyton

July 8, 2003